



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/695,663

10/29/2003

Michael G. Christofalo

043978-074000

4069

22204

7590

03/20/2008

NIXON PEABODY, LLP

401 9TH STREET, NW

SUITE 900

WASHINGTON, DC 20004-2128

EXAMINER

SMITH, CHENEA

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

03/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/695,663	<b>Applicant(s)</b> CHRISTOFALO ET AL.	
	<b>Examiner</b> CHENEA P. SMITH	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to communications filed 12/20/2007. Claim 1 is amended. Claims 2-10 are original. Claims 1-10 are pending in this action.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi (US6487721, hereinafter Safadi) in view of Ridderheim et al. (US6986153, hereinafter Ridderheim).

Regarding claim 1, Safadi discloses a system for inserting commands into a digital programming signal (see Fig. 1), comprising:

a digital ad server which generates ad content (ad server 150, see Fig. 1 and col 5, lines 14-16), and

a digital splicer (encoder/mux 120, see Fig. 3) which receives a message (protocol message, see col 8, lines 10-15), the message being separate from generated ad content (the message must be separate from the ad content since either the ad *or* the cue command may be inserted, see col 5, lines 53-57), extracts the attached command (see col 8, lines 25-28) and splices the command into a digital transport stream (see col 8, lines 29-34) including program content (see col 4, lines 46-53), the command being inserted separately from the program content in the digital transport stream (the program content is put into the transport stream first, see col 4, lines 46-55, and then the command is inserted, see col 8, lines 10-15 and col 7, lines 66-67, i.e., the command being inserted separately from the program content in the digital transport stream).

Safadi does not specifically disclose an ad server generating ad content and a message being separate from generated ad content.

In an analogous art, Ridderheim discloses ad server (central broadcast station 2, see Fig. 1) generating ad content (see col 7, line 65 – col 8, line 8), and a message being separate from generated ad content (see col 10, lines 39-43).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Safadi's system to include ad server generating ad content and a message being separate from generated ad content, as disclosed by Ridderheim, for the advantage of

allowing the message to be sent at a time different from the ad content, while preserving frame accuracy.

Regarding claim 9, Safadi in view of Ridderheim discloses a command spliced into the digital transport stream on a frame accurate basis (see Ridderheim, col 10, lines 43-44).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify Safadi's system to include a command spliced into the digital transport stream on a frame accurate basis, as disclosed by Ridderheim, for the advantage of maintaining time synchronization between the control signal and the media data that it refers to.

5. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi (previously cited) in view of Ridderheim (previously cited), as applied to claim 1 above, and further in view of Eldering et al. (US20020178445, hereinafter Eldering).

Regarding claim 2, Safadi in view of Ridderheim does not specifically disclose a message which is in a DVS380 compliant format.

In an analogous art, Eldering discloses a message which is in a DVS380 compliant format (see Eldering, [0060]).

It would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the system of Safadi in view of Ridderheim to include a message which is in a DVS380 compliant format, as disclosed by Eldering, for the advantage of providing an efficient system for advertising insertion using a well-known and accepted protocol.

Regarding claim 3, Safadi in view of Ridderheim, and further in view of Eldering discloses a DVS380 compliant message including at least one descriptor (inherent that a descriptor is included since descriptors are part of the standard format of a DVS 380 message, see Eldering, [0060]).

Regarding claim 4, Safadi in view of Ridderheim, and further in view of Eldering discloses a DVS380 splice request message (inherent that a splice request message is included since splice request messages are part of the standard format of the DVS 380 splicing technique, see Eldering, [0060]).

6. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi (previously cited) in view of Ridderheim (previously cited) and Eldering (previously cited) , as applied to claim 2 above, and further in view of Applicant's conceded prior art.

Regarding claims 5-6, Safadi in view of Ridderheim and Eldering fails to specifically disclose that the descriptor includes a field for inserting various commands, more than one command and time indications as recited in the claims.

However, Applicant's admitted prior art at page 10 paragraphs 21 and 22 of the specification describe inserting commands in digital transmission systems. Although applicant indicated that the process "was not robust" it is a clear indication that the process of inserting digital commands in digital transmission systems was well known in the art.

Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the system of Safadi in view of Ridderheim and Eldering (if necessary) to include inserting various commands in the descriptor or other fields of a digital

Art Unit: 2623

signal, as taught by applicant's conceded prior art, for the widely accepted benefit of commanding set top receivers to provide one or more particular advertisements from a plurality of advertisements.

7. Claims 7-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi (previously cited) in view of Ridderheim (previously cited), as applied to claim 1 above, and further in view of Applicant's conceded prior art.

Regarding claims 7-8 and 10, Safadi in view of Ridderheim fails to specifically disclose a message in DVS380 format, or commands provided in a descriptor field.

However, Applicant's admitted prior art at page 10 paragraphs 21 and 22 of the specification describe inserting commands in digital transmission systems. Although applicant indicated that the process "was not robust" it is a clear indication that the process of inserting digital commands in digital transmission systems was well known in the art.

Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the system of Safadi in view of Ridderheim (if necessary) to include a message in DVS380 format, or commands provided in a descriptor field, as taught by applicant's conceded prior art, for the widely accepted benefit of commanding set top receivers to provide one or more particular advertisements from a plurality of advertisements.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENEA P. SMITH whose telephone number is (571)272-9524. The examiner can normally be reached on Monday through Friday, 7:30 am - 5:00 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Son P Huynh/  
Primary Examiner, Art Unit 2623

/Chenea P. Smith/  
Examiner, Art Unit 2623